

Remarks

Claims 5, 7 and 8 are active. Fig. 8 is objected to as requiring the legend "PRIOR ART." Claims 7 and 8 are rejected under 35 USC 112, 1st paragr. on the basis that the missing vulcanizing step is critical or essential to the claim. Claims 5 and 7-8 are rejected under 35 USC 112, 2nd paragr. No art is cited against the claims.

Amended claims 5, 7 and 8 are submitted for the Examiner's reconsideration. Amendment is made to Fig. 8, copy enclosed, as requested. Fig. 8 is believed acceptable. Approval of the amendment to Fig. 8 to add the legend "PRIOR ART" is respectfully requested.

The claims are amended to meet the rejections based on formal matters. With respect to the rejection of claims 7-8 as being non-enabling, applicants traverse this reasoning as contrary to 35 USC 112, 1st paragr. and the law. Applicants are entitled to claim that which they regard as their invention. There is no requirement in 35 USC 112, 1st paragr. that a claim must include all features of a disclosed embodiment. 35 USC 112, 1st paragraph is directed to the written description wherein the specification must describe how to make and how to use the invention. MPEP 2164. The so called "invention" is what is claimed.

"The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention." (emphasis added) "As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied." (citing case)

MPEP 2164.01(b)

An enablement requirement is not directed to the content of the claim subject matter, but to the specification as providing support for what is claimed. If the Action is referring to 112, 2nd paragraph, then this is complied with as applicants particularly point out and distinctly claim the subject matter which applicant regards as their invention. There is no requirement in 35 USC 112 that a claim must claim every feature disclosed in the specification. This is not what the enablement requirement is about. Applicants are not aware of any rule or case law that requires otherwise.

"As concerns the breadth of a claim relevant to enablement, the only relevant concern should be whether the scope of enablement provided one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims." MPEP 2165.08, p. 2100-203, last paragr. right hand col. This requirement is met. It is the claims that define an invention, not the specification, which is only an example of an embodiment. Applicants respectfully request that authority for the interpretation of 35 USC 112, 1st paragr. set forth in the Action be provided, because applicants are not aware of any.

However, to advance the prosecution of this application, minor amendment is made to claim 7 in the interest of meeting the so called enablement requirement. In this respect claim 7 is amended to call for

"In a method for manufacturing rubber parts . . ."

Plainly, the method steps that follow are in a method for manufacturing rubber parts. This is what applicants regard as their invention. That is all that 35 USC 112 requires. This

rejection should be withdrawn.

The remaining objections to the various claims are believed met by the amendments to the claims. The objections to the claims based on formal matters are believed met and this basis of the rejection should be withdrawn. Since no art is cited against the claims, applicants believe that claims 5 and 7-8 are in proper form for allowance and such action is respectfully requested.

While no fee is believed due for this paper, the Commissioner is authorized to charge or credit deposit account 03 0678 for any under or overpayments with respect to this paper.

Respectfully submitted,
Shin-ichiro ENO et al.

By: William Squire, Reg. No. 25378
Attorney for Applicants
CARELLA, BYRNE,BAIN, GILFILLAN,
CECCHI, STEWART & OLSTEIN
5 Becker Farm Road
Roseland, NJ 07068
Tel: (973)994-1700
Fax: (973)994-1744
email: wsquire@carellabyrne.com

331633v2